

### REMARKS

Claims 1-36 and 39 were previously canceled. Claims 37, 38, 40, 44, 49, and 51 are amended herein. Thus, claims 37, 38 and 40 – 51 are pending and presented for examination. Applicants respectfully request allowance of the present application in view of the foregoing amendments and following remarks.

Support for the amendments can be found throughout the specification including but not limited to paragraphs [00018], [00023], [00038]-[00043], [00048] – [00049], and [00056]. No new matter has been added.

#### Claim Objections

Claim 40 was objected to because of an informality which Applicant has addressed according to the Examiner's suggestion. Accordingly, Applicant requests that the objection be withdrawn.

#### Response to Rejections under Section 103

The Examiner rejected claims 37 – 38 and 40 - 51 under 35 USC 103 as being obvious over *Hung* 6,587,754 in view of *McDaniel* 5,105,365. This rejection is respectfully traversed.

The Office bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. 103. To establish *prima facie* obviousness of a claimed invention, all the claims limitations must be considered for judging the patentability of the claim against the prior art.

Applicant has amended the independent claims to better distinguish the patentable aspects of the present invention.

Specifically, Claim 37, as amended, provides:

"...a predefined **two-part standardized procedure** for reducing energy costs comprising a **first standardized diagnostic method** that analyses energy-relevant operational processes using diagnostics that are **independent** of the sector industry allowing benchmarking based on a large number of companies across a plurality of industry sectors and a

**second standardized analysis method** selected from a plurality of standardized analysis packages each **specific to a particular sector of industry**, said first standardized diagnostic method and said second standardized analysis method..."

"...wherein the second standardized analysis method comprises **standardized analysis packages individually selectable by the facility from a plurality of standardized analysis packages for the particular sector of industry of the facility...**" and

"...repeating step (a) of analyzing and benchmarking the plurality of energy-relevant operational process sequences of the facility using the first standardized diagnostic method after a predetermined time interval **to carry out another benchmark** with other facilities to check an effectiveness of the energy cost reduction measures and continuing with process steps (b) - (e) based on the benchmarking."

Similarly, Claim 49, as amended, provides:

"...a **two-part standardized procedure** for a holistic consideration of the energy flow through the facility comprising **a first standardized diagnostic method** that analyses energy-relevant operational processes using diagnostics that are **independent** of the sector industry allowing benchmarking based on a large number of companies **across a plurality of industry sectors** and **a second standardized analysis method** selected from a plurality of standardized analysis packages each specific to a **particular sector of industry...**"

"...a plurality of **standardized analysis packages that are individually selectable by the facility from a plurality of standardized analysis packages for the particular sector of industry of the facility...**" and

"...control tools for executing the two-part standardized procedure in order to **benchmark the facility with other facilities using the first standardized diagnostic method** and to determine potential cost reductions using the **second standardized analysis method.**"

Without conceding the propriety of the asserted combination, Applicant respectfully submits that the asserted combination does not disclose the limitations of the claims.

*Hung* describes a steam-generation management system remotely measures amounts of utility used by steam-generating systems; monitors and compares their performance against benchmarked performance; analyzes and determines causes for variances in their performance; and recommends to the steam user actions for achieving optimum operation. The steam-generation management also permits remote access and interaction by the user and allows for integrating steam-related information into an overall strategy for managing steam and energy supply. *McDaniel* describes a system for assisting the implementation of an environmental compliance program using microcomputer hardware and software to automatically revise the test sampling frequency of potentially hazardous substances based on estimates of risk of exposure derived from sample data.

With respect to independent claim 37, neither reference describes or suggests the two-part procedure having a FIRST diagnostic method for benchmarking with other facilities independent of sector of industry AND a SECOND analysis method having selectable analysis packages for the particular sector of industry for determining energy cost reduction measures. Moreover, the method also includes repeating after a time interval the analyzing and benchmarking to check an effectiveness of the energy cost reduction measures and continuing with the remaining process based on the benchmarking.

Similarly, with respect to independent claim 49, neither reference describes or suggests a method handbook comprising the two-part procedure having a FIRST diagnostic method for benchmarking with other facilities independent of sector of industry AND a SECOND analysis method for determining energy cost reduction measures, a knowledge database having the selectable analysis packages for the particular sector of industry for the second analysis.

The applied references do not teach or suggest each and every claim limitation; therefore, *Hung* and *McDaniel*, taken alone or in combination, do not render claims 37 and 49 obvious. Since the remaining claims depend from claims 37 and 49, the same distinctions between *Hung* and *McDaniel* and the invention recited in the dependent claims apply for these claims. Additionally, the dependent claims recite other additional combinations of features not taught or

suggested by the references. Accordingly, Applicant respectfully requests that the outstanding rejections of the claims be reconsidered and withdrawn.

Conclusion

Accordingly, Applicant submits that all claims are in condition for allowance and requests that a Notice of Allowance be issued. The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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By: Janet D. Hood  
Janet D. Hood  
Registration No. 61,142  
(407) 736-4234

Siemens Corporation  
Intellectual Property Department  
170 Wood Avenue South  
Iselin, New Jersey 08830